

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Scott E. ANDERSEN *et al.*

Appeal No.: 2003-1137

Appln. No.: 09/540,232

Filed: April 3, 2000

Confirmation No. 9947

Art Unit: 1631

Examiner: Marianne P. ALLEN

Atty. Docket: 16517.317

For: Nucleic Acid Molecules and Other Molecules Associated with Plants

Request to Publish Opinion in Support of Board Decision as
Binding Precedent

Mail Stop 8

Director of the U.S. Patent and Trademark Office

P.O. Box 1405

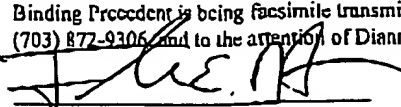
Alexandria, VA 22313-1450

Sir:

Appellant hereby requests that the opinion in support of the decision of the Board of Appeals and Interferences ("Board") in the above-captioned appeal be published as binding precedent.

On June 30, 2004 the Office mailed a decision of the Board in the above-captioned appeal (Paper No. 22) ("Decision") indicating that "[t]he opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board." Appellant respectfully requests that the Office publish this Decision as binding precedent.

I hereby certify that the foregoing Request to Publish Opinion in Support of Board Decision as Binding Precedent is being facsimile transmitted to the Office of the Solicitor via facsimile number (703) 872-9306 and to the attention of Dianne E. Maggard via facsimile number (703) 308-6200.


Thomas E. Holsten (Reg. No. 46,098)

August 6, 2004

A. The Opinion of the Board Should be Published as Binding Precedent

Ex Parte Holt, 19 U.S.P.Q.2d 1211 (B.P.A.I. 1991) provides criteria for when a decision should be published as a precedential opinion.¹ In *Ex Parte Holt*, the Board stated that in most cases, a published decision will be one that "significantly adds to the body of law addressing a substantive legal point not specifically previously addressed by the Federal Circuit ... or informs the patent bar and examining corps how the Board is interpreting prior court or Board decisions as they relate to particular factual situations...." *Id.* at 1214. The Board also noted that opinions are generally authorized for publication where the opinion is: "(a) consistent with other decisions which have been rendered by the Board and (b) consistent with binding precedent by the Federal Circuit." *Id.*

Appellant requests that the Office publish the Decision as binding precedent because the Decision is one that significantly adds to the body of law by addressing whether partial nucleic acid molecules, such as Expressed Sequence Tags ("ESTs"), have utility.² To date, neither the United States Court of Appeals for the Federal Circuit ("Federal Circuit") nor the Court of Customs and Patent Appeals ("CCPA") has addressed the issue. The Board further addresses the public policy implications of issuing patents on ESTs. In particular, the Board discusses and applies a "tragedy of the anticommons" policy for EST patents. The Board analyzes and applies the concepts addressed by Michael A. Heller & Rebecca S. Eisenberg, *Can patents deter innovation? The anticommons in biomedical research*, 280 Science, 698 (1998) as well as the decision in *Sear, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 140 USPQ 524 (1964) for support of the public policy arguments.

¹ Internal PTO procedures for the publication of opinions as binding precedent is governed by the Board's Standard Operating Procedure 2 (Revision 4), effective March 29, 2000, which notes that "public policy favors widespread publication of opinions."

² The commercial importance of ESTs is evident from the growth of a multi-million dollar industry in the United States premised on the use of ESTs. Nucleic acid molecules with EST sequences are bought and sold in the biotechnology industry, as are microarrays composed of nucleic acid molecules with EST sequences. In addition, many biotechnology companies derive significant revenue from EST technology. Such technology is often licensed through agreements that require the transfer of either the clones from which the ESTs were obtained, or the information necessary to make nucleic acid molecules with the EST sequences.

Moreover, the Decision warrants publication as binding precedent as it informs the patent bar and examining corps how the Board is interpreting prior court decisions as they relate to particular factual situations before the Board.³ The Decision discusses United States Supreme Court, Federal Circuit and CCPA precedent and applies that precedent to the utility of ESTs. In particular, the Board interprets the utility standard set forth by the Supreme Court in *Brenner v. Manson*, 318 U.S. 519 (1966) and its progeny from the Federal Circuit and CCPA. For example, the Decision analyzes and applies *In re Kirk*, 376 F.2d 936, 153 U.S.P.Q. 48 (C.C.P.A. 1967), *In re Ziegler*, 992 F.2d 1197, 26 U.S.P.Q.2d 1600 (Fed. Cir. 1993), *In re Jolles*, 628 F.2d 1322, 206 U.S.P.Q. 885 (C.C.P.A. 1980), *Cross v. Izuka*, 753 F.2d 1040, 224 U.S.P.Q. 739 (Fed. Cir. 1985) and *In re Brana*, 51 F.3d 1560, 34 U.S.P.Q.2d 1436 (Fed. Cir. 1995).

In addition, the Board's Decision in this appeal is consistent with multiple other decisions of which the Appellant is aware.⁴ In Appeal Nos. 2002-0078 (Application Ser. No. 09/206,040), 2002-2046 (Application Ser. No. 09/619,643)⁵, 2003-0996 (Application Ser. No. 09/540,215), 2003-1135 (Application Ser. No. 09/565,240), 2003-1504 (Application Ser. No. 09/440,687), 2003-1744 (Application Ser. No. 09/654,617), and 2003-1746 (Application Ser. No. 09/620,392) the Board considered the utility of EST and genomic sequences from soybean, maize, rice, Arabidopsis, an algae and lilly and reached similar conclusions in those appeals. Finally, although Appellant does not agree with the Board's interpretation of the utility standard, the Decision analyzes and applies United States Supreme Court, Federal Circuit and CCPA precedent.⁶

For these reasons, Appellant respectfully requests that the Decision in the above-captioned case be published as binding precedent. Should the Commissioner require

³ *Ex parte Holt*, 19 U.S.P.Q.2d at 1214 (stating that "[I]n most instances, a published Board opinion will be one which ... (3) informs the patent bar and examining corps how the Board is interpreting prior court or Board decisions as they related to particular factual situations before the Board.")

⁴ *Id.* (stating that "[G]enerally, the Board authorizes publication of its opinions only in those instances in which the opinion is (a) consistent with other decisions which have been rendered by the Board")

⁵ Appellant notes that a Request to Publish Opinion in Support of Board Decision as Binding Precedent was filed on May 12, 2004 in Appeal No. 2002-2046. In addition, Appeal No. 2002-2046 has also been appealed to the United States Court of Appeals for the Federal Circuit.

⁶ *Id.* (stating that "[G]enerally, the Board authorizes publication of its opinions only in those instances in which the opinion is ... (b) consistent with binding precedent by the Federal Circuit.")

additional information, he is invited to contact the undersigned at the number provided below.

Respectfully submitted,



David R. Marsh (Reg. No. 41,408)
Thomas E. Holsten (Reg. No. 46,098)
ARNOLD & PORTER LLP

Date: August 6, 2004

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August 6, 2004

VIA FACSIMILE

Mail Stop 8
Director of the U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Appeal No. 2003-1137

Re: U.S. Patent Application Serial No. 09/540,232 filed April 3, 2000
Inventors: Scott E. ANDERSEN *et al.*
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants
Atty. Dkt: 16517.317

Sir:

Transmitted herewith for appropriate action by the U.S. Patent and Trademark Office, is a Request to Publish Opinion in Support of Board Decision as Binding Precedent. A courtesy copy of this letter and its attachment is being sent via facsimile to the attention of Dianne E. Maggard.

In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned. Appellants do not believe any additional fees are due in conjunction with this filing. However, if any fees are required in the present application, including any fees for extensions of time, then the Commissioner is hereby authorized to charge such fees to Arnold & Porter LLP Deposit Account No. 50-2387, referencing docket number 16517.317.

Sincerely,



Thomas E. Holsten (Reg. No. 46,098)
David R. Marsh (Reg. No. 41,408)

Attachment

I hereby certify that the foregoing transmittal letter and Request to Publish Opinion in Support of Board Decision as Binding Precedent is being facsimile transmitted to the attention of the Office of the Solicitor via facsimile number (703) 872-9306, and to the attention of Dianne E. Maggard via facsimile number (703) 308-6200.


Thomas E. Holsten (Reg. No. 46,098)

August 6, 2004

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August 6, 2004

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Thomas E. Holsten	(202) 942-5085	981
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MESSAGE		

Re: U.S. Patent Application Ser. No. 09/540,232 filed April 3, 2000

Appeal No. 2003-1137

Confirmation No. 9947

Title: Nucleic Acid Molecules and Other Molecules Associated with Plants

Inventors: Scott E. ANDERSEN *et al.*

Atty. Dkt.: 16517.317

Please see the attached.

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